

REMARKS

Claims 1-20 are pending in the present application.

This Amendment is in response to the Final Office Action mailed August 18, 2010. In the Final Office Action, the Examiner rejected claims 12-14 under 35 U.S.C. §101; claims 1-3, 7-8, and 11-17 under 35 U.S.C. §102(b); and claims 4-6, 9-10, and 18-20 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein is respectfully requested.

Response to Arguments

In the Response to Argument section of the Final Office Action, the Examiner alleges that “the claims recite the intended use of a virtual machine... [and] a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art is capable of performing the intended use, then it meets the claim.” (Final Office Action, page 2). Applicant respectfully disagrees and submits that the claims recite: “receiving in a virtual machine contents of a program for creating a virtual environment for interacting with a host platform in a computing device,” as recited in independent claims 1, 7, and 12 and “determining by the virtual machine if the received contents comprises predetermined instructions for performing at least one unauthorized task,” as recited in independent claims 1, 7, 12, 15, and 18.

Applicant submits that the Examiner misconstrues the language of the claims and the requirements of the MPEP. MPEP § 2111.02 recites *inter alia*: “During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).” Here, the Examiner alleges that the claims merely recite an intended use of a virtual machine. However, the virtual machine is not recited in the preamble but rather in the body of the claims. For instance, claim 7 expressly recites: “A system comprising: a virtual machine...” Thus, Applicant submits that in order to reject the

claims under Swimmer, the Examiner improperly ignores the language “virtual machine” in the claims.

The Examiner further alleges that Altman explicitly discloses the use of a virtual machine such that Applicant has not overcome the rejection of the claims (Final Office Action, page 2). Applicant respectfully submits that “[t]o defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention.” *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). “To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. Applicant submits that the Examiner improperly uses hindsight reconstruction to combine Swimmer and Altman given that Swimmer discloses a host based sensor 14 which is a physical device and Altman merely recites a virtual machine.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-3, 7-8, and 11-17 under 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2004/0255163A1 issued to Swimmer et al. (“Swimmer”). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of anticipation.

Swimmer does not disclose, either expressly or inherently, “receiving in a virtual machine contents of a program for creating a virtual environment for interacting with a host platform in a computing device,” as recited in independent claims 1, 7, and 12 and “determining by the virtual machine if the received contents comprises predetermined instructions for performing at least one unauthorized task,” as recited in independent claims 1, 7, 12, 15, and 18.

Swimmer merely discloses monitoring, via a sensor, system calls from a daemon executed in a memory of the monitored data processing system (Swimmer, par. [0017]). An

intrusion limitation subsystem preferably comprises a pattern filter connected to a code extractor for receiving extracted malicious code strings (Swimmer, par. [0022]). As shown in Figure 2, the daemon 12 can indirectly access the operating system 11 by means of system calls 44 that can be easily intercepted and examined (Swimmer, par. [0045]). The intrusion detection system comprises a host or application based sensor (14) for detecting code based intrusions with a relatively low false-positive rate (Swimmer, par. [0078]). The host based sensor 14 observes interactions between the daemon 12 and the operating system 11 (Swimmer, par. [0045]).

In the Office Action, the Examiner alleges that intrusion detection system that comprises a host based sensor 14 in Swimmer corresponds to “a virtual machine.” Applicant respectfully disagrees and submits that the MPEP states “that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” See MPEP § 2111.01. Here, as per the plain meaning and as stated in the specification, “[a] virtual machine, such as dynamic binary translator, Just-in-Time compiler, or Java Virtual Machine Interpreter, etc. is an abstract computing device that virtualizes an environment on which a computer program can run on a host platform. In this way, the same computer program can be run on different (and otherwise incompatible) operating systems host platforms. In addition a virtual machine can enable a computer program to run on computers with different architectures.” (See Specification, par. [0003]). In Swimmer, the intrusion detection system merely comprises sensor 14 and detects code based intrusions within the interactions between the daemon 12 and the operating system 11. Thus, the intrusion detection system which merely comprises a sensor 14 that pattern filters cannot correspond to “a virtual machine” because it is not inter alia “an abstract computing device that virtualizes an environment.”

Applicant further submits that a *prima facie* case of anticipation has not been established for dependent claims 3, 8, 11, 13-14, and 16-17. However, based on the dependency of claims 3, 8, 11, 13-14, and 16-17 on independent claims 1, 7, 12, and 15, respectively, which are believed to be in condition for allowance, Applicant respectfully submits that claims 3, 8, 11, 13-14, and 16-17 are believed to be allowable for at least the reasons set forth above.

To anticipate a claim, the reference must teach every element of a the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Vergeaal Bros. v. Union Oil Co. of

California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the...claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Since the Examiner failed to show that Swimmer teaches or discloses any of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicant believes that independent claims 1, 7, 12, and 18 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §102(b) be withdrawn.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 4-6 and 9-10 under 35 U.S.C. §103(a) as being unpatentable over Swimmer as applied to claim 2 above, and further in view of U.S. Publication No. 2004/0044880A1 issued to Altman et al. (“Altman”); claim 18 under 35 U.S.C. §103(a) as being unpatentable over Swimmer and further in view of U.S. Patent No. 5,873,124 issued to Draves (“Draves”); claims 19-20 under 35 U.S.C. §103(a) as being unpatentable over Swimmer and Draves, as applied to claim 18 above, and further in view of Altman. Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, certain basic criteria must be met. For instance, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §2143. Applicant respectfully submits that the combined teachings do not address each and every limitation, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” MPEP §2141. In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of

demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order *to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.*” *Emphasis Added.* The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

In the instant case, Applicant respectfully submits that the combined teachings of the cited prior art references do not teach or suggest all the claim limitations. As discussed above, Swimmer fails to disclose “receiving in a virtual machine contents of a program for creating a virtual environment for interacting with a host platform in a computing device,” as recited in independent claims 1, 7, and 12 and “determining by the virtual machine if the received contents comprises predetermined instructions for performing at least one unauthorized task,” as recited in independent claims 1, 7, 12, 15, and 18. Based on the dependency of claims 2, 4-6, 9-10, and 19-20 on independent claims 1, 7, and 18, respectively, which are believed to be in condition for allowance, Applicant respectfully submits that claims 2, 4-6, 9-10, and 19-20 are believed to be allowable for at least the reasons set forth above.

Therefore, Applicant believes that independent claims 1, 7, 12, and 18 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: October 7, 2010

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